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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,954	05/02/2006	Klaus Schultes	286273US0PCT	5266
22850	7590	07/15/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
BOYKIN, TERRESSA M				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
07/15/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/577,954

Applicant(s)

SCHULTES ET AL.

Examiner

Terressa M. Boykin

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 6-26-8
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

Response to Arguments

Applicant's arguments filed 6-11-8 have been fully considered but they are not persuasive. Although applicants' arguments are well noted, the limitations upon which the applicants are now relying appear to be questionable with regard to newly amended matter.

Although applicants have supplied where the support exist, it should be noted that not only should support be set forth and identified for the wording of the limitations or any additional matter but *the context* to which the limitation applies should be the same. In order to expedite prosecution of the case, an additional search will be performed in the event that appropriate support is identified while applicants are given an opportunity to clarify and identify the page and line the supporting limitations if such do exist.

Further, it is noted that applicants have omitted certain limitations from the claims which appear to be necessary to the scope of the original invention.

Response to Amendment

Claims 1-17, 19-20 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling.

Applicants newly amended limitations and the deletion of the original parameters appear to be new matter since although in certain instances the "exact wording" may be found in the specification, the context upon which it appears to be directed or meant to be directed is that of the polycarbonate and not to that the polyacrylate. Note page

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of applicants specification describe the same limitations in the context of the polycarbonate. .

Further it is not clear whether the newly amended deletions have now *changed the scope of the original invention* in that the claims appear to be broader in scope and thus may be fully supported.

In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. 112, first paragraph, *Waldemar Link, GmbH & Co. v. Osteonics Corp.* 32 F.3d 556, 559, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). See MPEP 2163.06-.07(b) for a discussion of the relationship of new matter to 35 U.S.C. 112, first paragraph. New matter includes not only the addition of wholly unsupported subject matter, but may also include adding specific percentages or compounds after a broader original disclosure, **or even the omission of a step from a method. See MPEP § 608.04 to § 608.04(c). See *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) and MPEP § 2163.05 for guidance in determining whether the addition of specific percentages or compounds after a broader original disclosure constitutes new matter** .

2163.06 Relationship of Written Description Requirement to New Matter

Lack of written description is an issue that generally arises with respect to the subject matter of a claim. If an applicant amends or attempts to amend the abstract, specification or drawings of an application, an issue of new matter will arise if the content of the amendment is not described in the application as filed. Stated another way, information contained in any one of the specification, claims or drawings of the

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application as filed may be added to any other part of the application without introducing new matter.

There are two statutory provisions that prohibit the introduction of new matter: 35 U.S.C. 132 - No amendment shall introduce new matter into the disclosure of the invention; and, similarly providing for a reissue application, 35 U.S.C. 251 - No new matter shall be introduced into the application for reissue.

III. CLAIMED SUBJECT MATTER NOT DISCLOSED IN REMAINDER OF SPECIFICATION

The claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985). Form Paragraph 7.44 may be used where originally claimed subject matter lacks proper antecedent basis in the specification. See MPEP 608.01(o).

The response to the original **35 USC 112 rejection** has been considered but does not appear to obviate the original rejection in view of the above.

The response to the **35 USC 102/103** rejection has been considered, however, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that applicants have not properly addressed or acknowledged that the rejection was not made as a separate 102 or 103 rejection but as an inherency rejection. Therefore, it is the burden of the applications to show how those limitations as mentioned are not inherent since the multilayer films "appear" to be the same. Applicants are reminded that the Examiner is reading the claims in light of the 112 rejection above and although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In order to expedite the prosecution of the case an additional search will be sent out during the waiting for the response of applicants' comments, arguments and/or corrections.

The original rejections are set forth below for convenience and continuity of the case:

Claim Rejections - 35 USC § 112

Claims 1-15, 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants states in claim 1 that the claimed moiety is a multilayered film. However as written it can be interpreted or construed as having one continuous constitution which is contradictory of the recited term "multilayered. Note for example:

- a) methacrylate copolymerwith the polycarbonate of the backing layer
- b) ...*identical* or different methacrylate....
- c) ...up to 30%of the layers a) and b)

If applicants are intending to claim a multilayer film then each a) b) and c) moiety must be clearly distinguishable from the other in order to use the term "multilayer.

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However, if it is not necessary that the layers be distinguishable the term 'multilayer should not be used and would thus bring into question the whether or not the specification is enabling and/or commensurate in scope.

* It is understood that moiety a) contains a light stabilizer, while b) contains a dye, such is not distinguishable since applicant(s) comprising" in each instance, i.e. a) and b) is open language and does not exclude either of the additional moieties etc. disclosed herein. Thus, both a) and b) and c) may contain therein a dye and a light stabilizer.

Claim Rejections - 35 USC § 102/ 35 USC 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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polyvinylidene chloride, ethylene-vinyl chloride copolymers and polyphenylene sulfide. They can also be used as a mixture of two or more of them.

When the fine inorganic powder contained in the base material layer of the single-layer structure or the multi-layer structure exceeds 60% by weight, a stretched resin film is liable to break in transverse stretching performed after longitudinal stretching. When the fine inorganic powder contained in the surface layer exceeds 75% by weight, the surface strength of the surface layer after transverse stretching is low, resulting in material fracture of the surface layer in color development of printing ink.

When the thermoplastic resin film is the polyolefin resin film, as the organic filler, there is used one having a melting point (for example, from 170 to 300.degree. C.) or a glass transition temperature (for example, from 170 to 280.degree. C.) higher than the melting point of the polyolefin resin, such as polyethylene terephthalate, polybutylene terephthalate, a polycarbonate, nylon-6, nylon-6,6, nylon-6,12 or a cyclic olefin polymer. When the thermoplastic resin film is the polyolefin resin film and the single layer, and contains the organic filler, it contains usually 50 to 99.5% by weight of the polyolefin resin and 50 to 0.5% by weight of the organic filler, and preferably 60 to 97% by weight of the polyolefin resin and 40 to 3% by weight of the organic filler. When the thermoplastic resin film is the multi-layer structure and the base material layer and the surface layer contain the organic filler, usually, the base material layer contains 50 to 99.5% by weight of the polyolefin resin and 50 to 0.5% by weight of the organic filler, and the surface layer contains 35 to 100% by weight of the polyolefin resin and 65 to 0% by weight of the organic filler. Preferably, the base material layer contains 60 to 97% by weight of the polyolefin resin and 40 to 3% by weight of the organic filler, and the surface layer contains 40 to 97% by weight of the polyolefin resin and 60 to 3% by weight of the organic filler.

The above is an example of where applicant's claims may be interpreted to overlap or render obvious applicants invention.

A stabilizer, a light stabilizer, a dispersing agent, a lubricant, etc. may be further mixed therewith as needed. As the stabilizer, there may be mixed a stabilizer of the steric hindrance phenol family, the phosphorus family, the amine family, etc. in an amount of 0.001 to 1% by weight. As the light stabilizer, there may be mixed a light stabilizer of a steric hindrance amine, the benzotriazole family, the benzophenone family, etc. in an amount of 0.001 to 1% by weight. As the dispersing agent for the fine inorganic powder, there may be mixed, for example, a silane coupling agent, a higher fatty acid such as oleic acid or stearic acid, metal soap, polyacrylic acid, polymethacrylic acid or a salt thereof in an amount of 0.01 to 4% by weight.

Specific examples of the monomers of the above-mentioned (a') can be obtained, for example, by modifying tertiary amine-containing monomers represented by the following general formula (VI), such as dimethylaminoethyl acrylate, diethylaminoethyl acrylate,

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methacrylate-corresponding compounds thereof, dimethylaminopropylacrylamide, methacrylate-corresponding compounds thereof, etc., with modifying agents represented by the following general formula (VII), such as 3-chloro-2-hydroxypropyltrimethylammonium chloride, etc., before or after polymerization. The hydrophobic monomer units of the above-mentioned component (b) include alkyl (meth)acrylates such as methyl (meth) acrylate, ethyl (meth) acrylate, butyl (meth) acrylate, isobutyl (meth) acrylate, tertiary butyl (meth) acrylate, cyclohexyl (meth) acrylate, 2-ethylhexyl (meth) acrylate, lauryl (meth) acrylate, dodecyl (meth) acrylate and stearyl (meth) acrylate.

A pattern was offset printed on the resulting base material resin film with Dia OF-4 (Kikuyonsai) manufactured by Mitsubishi Heavy Industries, Ltd., using oxidation polymerization type ink for synthetic paper four colors of black, cyan, magenda and yellow), and the density of transferred ink was measured. Further, for the transfer state of ink on the whole face, it was visually observed whether there was poor transfer such as coating streaks and blank areas or not, and the ink transfer was evaluated according to the following five grades:

Claim 1 of the reference discloses:

A thermoplastic resin film having on a surface thereof a hydroxy-modified imine polymer containing repeating units represented by the following general formula (I) in an amount of 5 mol % or more based on the total of repeating units: 20 wherein R^1 and R^2 are each independently a hydrogen atom, or a straight chain or branched alkyl group within the range of 1 to 10 carbon atoms, an alkyl group having an alicyclic structure or an aryl group, R^{3-9} are each independently a hydrogen atom, or an alkyl group within the range of 1 to 20 carbon atoms, a cycloalkyl group, an aryl group, an aralkyl group, an alkylaryl group, groups each alternately forming bonds to form a cyclic structure, an alkyloxyalkyl group having a straight chain, branched or alicyclic structure within the range of 1 to 20 carbon atoms, an alkylaryloxyalkyl group, a hydroxyalkyl group having a straight chain, branched or alicyclic structure within the range of 1 to 20 carbon atoms or an aryl group-containing hydroxyalkyl group, h is an integer ranging from 0 to 4, i is an integer ranging from 1 to 4, j is an integer ranging from 0 to 4, k is an integer ranging from 0 to 4 and m is an integer ranging from 2 to 6.

The reference **US Pub 20020054991** discloses a film prepared from the same components as claimed by applicants, and depending on the *optional component* of the claim, the film may be interpreted as disclosing one continuous film except for the particular amount of polycarbonate and methacrylates as claimed albeit the amounts do overlap. With regard to the recited "test specimen.....tensile strain at break (ISO 527-2) at 100° calculated as a relative value..." it is noted that any properties or characteristics inherent in the prior art, although unobserved or detected by the

reference, would still anticipate the claimed invention. **Note In re Swinehart, 169**

USPQ 226. "It is elementary that the mere recitation of a newly

discovered...property, inherently possessed by things in the prior art, does not cause claim drawn to those things to distinguish over the prior art". Further, it

would have been obvious to one having ordinary skill in the art at the time the invention was made to employ particular amounts as known in the art, or in this particular

instance the % amount by weight since it is well-established that merely selecting

proportions and ranges is not patentable absent a showing of criticality. In re Becket,

33 U.S.P.Q. 33 (C.C.P.A. 1937). In re Russell, 439 F.2d 1228, 169 U.S.P.Q. 426

(C.C.P.A. 1971). Generally, it is prima facie obvious to determine workable or optimal values within a prior art disclosure through the application of routine experimentation.

See In re Aller, 105 USPQ 233, 235 (CCPA 1955); In re Boesch, 205 USPQ 215 (CCPA 1980); and In re Peterson, 315 F.3d 1325 (CA Fed 2003). Since the disclosed amounts

are expressed differently, i.e. % percent by weight, and thus may be distinct from those claimed, it is incumbent upon applicant(s) to establish that they are in fact different and

whether such difference is unobvious. In view of the above, there appears to be no

significant difference between the reference and that which is claimed by applicant(s).

Consequently, the claimed invention *cannot be deemed as novel or unobvious* and accordingly is unpatentable.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terressa Boykin whose telephone number is (571) 272- 1069 . The examiner can normally be reached at (571) 272-0580 on Monday through Friday from 9:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck , can be reached at (571) 272- 1078 . The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**/Terressa M. Boykin/
Primary Examiner, Art Unit 1796**